

Duplicate of
Paper No. 12

P-3627-2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: DR. MICHAEL N. BERKE
FOR: SELF-ADMINISTERED BACK MASSAGE
SERIAL NO.: 09/609,166
FILED: JULY 3, 2000
EXAMINER: JUSTINE YU

COPY OF PAPERS
ORIGINALLY FILED

PETITION TO THE COMMISSIONER PURSUANT TO 37 CFR 1.181

Hon. Commissioner of Patents
and Trademarks
Washington, DC 20231

Sir:

A. Statement of Facts Involved

Annexed as Exhibit A hereto is an amended claim submitted in response to an Office Action of 08/31/01 placing the above captioned application under FINAL REJECTION.

In an Advisory Action of 09/27/01 the Exhibit A amended claim was refused entry.

B. Request for Reconsideration

A request for reconsideration dated October 9, 2001 was made pursuant to 37 CFR 1.181(c) to which the examiner issued an Advisory Action of 10/23/01 checking box 2 indicating the entry of applicant's "argument", presumably referring to the request of October 9, 2001.

C. The Point or Points To Be Reviewed

Whether the claim on appeal is, or is not, the amended claim of the office Action of 08/31/01 submitted after FINAL REJECTION.

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D. The Requisite Fee

Enclosed is a check for the fee of \$130.

E. The Relief Requested

That it be ordered that the claim on appeal is the Exhibit A amended claim and that the appeal thereof proceed or, in the alternative, that the final rejection status be withdrawn enabling the examiner to determine whether the amended claim is, or is not, allowable.

F. Appeal Brief

The checking of box 2 of the Exhibit B Advisory Action is ambiguous as to whether the claim on appeal is the Exhibit A amended claim or the claim applicant attempted to amend.

To check box 6 instead, which the examiner stated in a telephone conference she intended to do, does not clarify this point, because although the examiner is entitled to contend that the Exhibit A amended claim is not allowable, the applicant is entitled to have the Board address this issue of allowability, and the latter relief is not precluded by the checking of box 6.

In the Office Action of 08/31/01 placing this application under FINAL REJECTION, it was based in part on prior patent 5,113,847 to Holzworth, cited for the first time in the Office Action.

Because applicant had not had an opportunity to respond to the Holzworth patent, the Exhibit A amended claim was submitted and it was argued, inter alia, that the disclosure of Holzworth in column 6, lines 57-66 only goes so far that the examiner had to acknowledge it leaves undisclosed "a semi-spherical configuration being positioned on a vertically oriented rectangular strip" and the "undisclosed" matter in quotes was the thrust of the amendment to the claim, resulting in the Exhibit A amended claim.

The examiner did not respond on the merits but stated that the Exhibit A amended claim raised new issues without explanation, and thus no clear issue was developed whether the quoted structure was, or was not, that pertinent to the point of novelty as to require a further prior art search by the examiner. Applicant contends the structure added did not introduce a new concept but was a tactical narrowing of the claim to achieve an allowance over the cited reference, a narrowing that was not thought necessary on the merits, but agreed to by the applicant to foreshorten the prosecution of the application.

The MPEP, at Chapter 706.07, further exemplifies how a clear issue is developed when a single previous Office Action contains a complete statement of a ground of rejection by stating the final rejection may:

“... refer to such a statement and also should include a rebuttal of any arguments raised in the applicant’s reply.” (Emphasis added)

From the above facts, it is clear that the examiner did not establish a clear issue between the applicant and examiner that the addition of minor structure to the claim raised new issues going to patentability or was an arbitrary characterization of the examiner.

Therefore, due to the lack of a clear issue being developed between the examiner and the applicant, the finality of the 08/31/01 Office Action was premature, and should be withdrawn. Consequently, the examiner’s refusal, in the Advisory Action of 09/27/01, to enter/consider the applicant’s REPLY TO THE OFFICE ACTION OF 08/31/01 was inappropriate and should also be withdrawn.

This application should be forwarded to the examiner for entry and consideration of the applicant’s timely filed REPLY TO THE OFFICE ACTION OF 08/31/01.

An Office Action shall be ordered to follow in due course.

Respectfully,

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Dated: November 1, 2001

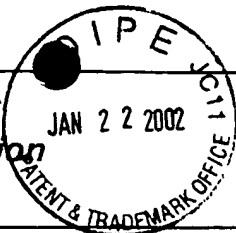
What is claimed is:

1. In a self-administered back massage applied to an individual by leaning contact against a semi-spherical configured massaging device, an improvement consisting of a method of facilitating establishing said leaning contact between said massaging device and a selected back area of said individual comprising the steps of:
 - A. using as a positioning site for a back massage a door frame having two opposite side walls bounding therebetween a vertical plane of a doorway opening;
 - B. using as a massaging device a construction comprising a base, a plurality of semi-spherical configurations extending from one side of said base, and a vertical notch in said base having walls bounding a positioning recess therebetween;
 - C. positioning said massaging device in a transverse relation to a vertically oriented rectangular strip disposed flat against said one side wall of said door frame and having projected in said positioning recess a vertical strip normally serving as a stop for a pivotal traverse of a door mounted in said doorway opening plane;
 - D. instructing an individual to assume a position in said plane of said doorway opening preparatory to establishing leaning engagement against said positioned massaging device; and
 - E. instructing said individual to supplement said established leaning engagement by pushing against the other of said side wall of said door

frame to cause movement of the individual in the direction of said
massaging device.

whereby bodily movements while maintaining said engagement provides a self-
administered back massage.

Advisory Action



Application No. 09/609,166	Applicant(s) Berke
Examiner Justine Yu	Art Unit 3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Oct 9, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
 - (b) ☐ they raise the issue of new matter. (See NOTE below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

4. ☐ Applicant's reply has overcome the following rejection(s): _____
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
 Claim(s) allowed: _____
 Claim(s) objected to: _____
 Claim(s) rejected: 1
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☒ Other: See attached paper

JUSTINE R. YU
PRIMARY EXAMINER

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